



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,298	09/27/2001	Dennis J. O'Rear	005950-657	5063

7590

08/27/2003

E. Joseph Gess
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

MCAVOY, ELLEN M

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 08/27/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,298

Applicant(s)

O'REAR, DENNIS J.

Examiner

Ellen M McAvoy

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08 August 2003 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berlowitz et al (6,080,301) or Berlowitz et al (6,165,949).

The amendments to the claims and arguments filed 08 August 2003 have been fully considered but the examiner maintains the position that the rejection of record over the Berlowitz et al ["Berlowitz"] references still applies. As set forth in the previous office action, the Berlowitz references disclose premium synthetic lubricating oil basestocks having a high viscosity index (VI) and low pour point which contain at least 95% by weight of non-cyclic isoparaffins. The lubricant basestocks are produced by hydroisomerizing waxy, Fischer-Tropsch synthesized hydrocarbons. See column 1, line 8, to column 2, line 14, of Berlowitz '301 and

Art Unit: 1764

column 1, lines 5-65 and column 4, lines 23-28 of Berlowitz '949. The lubricant basestocks contain sulfur, nitrogen and metals in amounts of less than 1 ppm by weight. The examiner maintains the position that these premium synthetic basestocks clearly meet the limitation of component (a) of the claims. The lubricant basestocks of the Berlowitz references may be mixed or blended with one or more additional basestocks selected from the group consisting of (a) hydrocarbonaceous base stock, (b) a synthetic base stock, and mixtures thereof. Typical examples include base stocks derived from (i) poly-alpha-olefins, (ii) conventional mineral oils, (iii) mineral oil slack wax hydroisomerates, and mixtures thereof. See column 2, lines 25-44, and column 5, top, of Berlowitz '301 and column 5, lines 43-56 of Berlowitz '949. Although the Berlowitz references do not classify the additional blended basestocks in terms of Groups I-V, applicant teaches in the specification on page 5 that the majority of lube production is in the Group I category which designates lube base oils containing greater than 300 ppm sulfur, a saturate content of less than 90% and a viscosity index of between 80-120. And, as set forth in Berlowitz '301, by "hydrocarbonaceous" it is meant a primarily hydrocarbon type base stock derived from a conventional mineral oil. Thus, the examiner maintains the position that the premium basestock blends of the Berlowitz references clearly meet the limitations of the lube base oil blends of the claims.

Applicant argues that in no way does Berlowitz '301 or Berlowitz '949 address the problem of achieving both good Oxidator A and Oxidator BN stability in lube base oils by providing a blend of a synthetic lube base oil, selected based on its Oxidator A value, and a non-synthetic lube base oil, selected based on its Oxidator BN value. Applicant argues that in no way

Art Unit: 1764

does Berlowitz teach or suggest that a blend of a synthetic lube base oil having poor oxidator A stability and a non-synthetic lube base oil having poor Oxidator BN stability provides a blended lube base oil with improved oxidation stability, including combined good Oxidator A and Oxidator BN stabilities. As set forth in the specification on page 6 Oxidator BN measures the response of a lubricating oil in a simulated application which includes both typical antioxidant additives and metal oxidation promoters that are typically found in finished lubricants during use, and that the Oxidator A test is conducted in the same fashion except that both the antioxidant additives and the metal oxidation promoters are omitted, which thus measures the oxidation stability of the oil during shipping and storage. Although the Berlowitz references do not describe the lube oil mixtures in terms of Oxidator A and Oxidator BN values, the examiner is of the position that a clear line of distinction between the claimed invention and the lube oil blends of the prior art is not seen to exist because component (a), at least one synthetic lube base oil having an iso-paraffin content greater than about 50%, and (b) at least one percent of a non-synthetic lube base oil, may be the same. The claims have been amended to include that component (a) which may be a synthetic lube prepared by the Fischer-Tropsch process, has an Oxidator A value of less than about 1. The examiner is of the position that the Fischer-Tropsch derived oils set forth in Berlowitz may and most likely do also have an Oxidator A value of less than 1 but were not characterized as such. It has been well known in the art that Fischer-Tropsch derived hydrocarbon oils are prone to oxidation because they contain almost no sulfur which is a natural antioxidant. As set forth in Berlowitz, premium synthetic lubricant base stocks of high purity may be derived from waxy Fischer-Tropsch hydrocarbons which contain contaminants

Art Unit: 1764

such as sulfur, nitrogen and metals in amounts of less than 1 wppm . See column 3, lines 58-64 of '301. Applicant has amended component (b) of the claims to include the phrase "the non-synthetic lube base oil has an Oxidator BN value in the presence of additives of less than about 7" and applicant argues that this distinguishes the claims over Berlowitz. This is not deemed to be persuasive because the "additives" are not taught; and, as previously set forth, Berlowitz teaches that fully formulated lubricating oils may be prepared by adding to the base stock an effective amount of at least one additive or, more typically, an additive package containing more than one additive wherein the additive is an antioxidant. See column 4, lines 30 et seq. of '301. The Declaration under Rule 132 setting forth Oxidator BN values for various lubricating oils has been considered. Only 9 of the 38 oils tested have an Oxidator BN value less than 7 which is required by the claims. However, the additives in the basestocks have not been set forth and it would seem that the Oxidator BN value is dependent upon both the type and amount of additives. Presumably the same additive package has been added to the various base stocks to show a comparison of the different base stocks. In any event, Berlowitz also teaches fully formulated lubricating oils and, although not describing the oils in terms of an Oxidator BN value, the oils of Berlowitz may be the same as the oils applicant requires for component (b) of the claims. The examiner maintains the position that it is not clear that the claims at issue differ from the possible oil compositions taught by Berlowitz.

Claim Rejections - 35 USC § 103

Claims 1-14 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Wittenbrink et al (6,332,974).

The amendments to the claims and arguments filed 08 August 2003 have been fully considered but the examiner maintains the position that the rejection of record over the Wittenbrink et al ["Wittenbrink"] still applies. As set forth in the previous office action, Wittenbrink disclose a wide-cut lubricant base stock having a low pour point and high viscosity index (VI) which is made by hydroisomerizing and then catalytically dewaxing a waxy Fischer-Tropsch synthesized hydrocarbon fraction. The base stock comprises at least 95% by weight of non-cyclic isoparaffins. See column 4, lines 5-38. The base stocks of Wittenbrink may also be blended with an additional lubricant base stock which may be selected from the group consisting of (i) a hydrocarbonaceous base stock, (ii) a synthetic base stock and mixtures thereof. See column 4, lines 33-50. Wittenbrink teaches that by "hydrocarbonaceous" it is meant a primarily hydrocarbon type base stock derived from a conventional mineral oil, shale oil, tar, coal liquefaction, and mineral oil derived slack wax. Thus the examiner maintains the position that Wittenbrink also clearly meets the limitations of the claimed lubricant base oil blends.

Applicant argues that in no way does Wittenbrink address the problem of achieving both good Oxidator A and Oxidator BN stability in lube base oils by providing a blend of a synthetic lube base oil, selected based on its Oxidator A value, and a non-synthetic lube base oil, selected based on its Oxidator BN value. Applicant argues that in no way does Wittenbrink teach or

suggest that a blend of a synthetic lube base oil having poor oxidator A stability and a non-synthetic lube base oil having poor Oxidator BN stability provides a blended lube base oil with improved oxidation stability, including combined good Oxidator A and Oxidator BN stabilities. As set forth in the specification on page 6 Oxidator BN measures the response of a lubricating oil in a simulated application which includes both typical antioxidant additives and metal oxidation promoters that are typically found in finished lubricants during use, and that the Oxidator A test is conducted in the same fashion except that both the antioxidant additives and the metal oxidation promoters are omitted, which thus measures the oxidation stability of the oil during shipping and storage. Although Wittenbrink does not describe the lube oil mixtures in terms of Oxidator A and Oxidator BN values, the examiner is of the position that a clear line of distinction between the claimed invention and the lube oil blends of the prior art is not seen to exist because component (a), at least one synthetic lube base oil having an iso-paraffin content greater than about 50%, and (b) at least one percent of a non-synthetic lube base oil, may be the same. The claims have been amended to include that component (a) which may be a synthetic lube prepared by the Fischer-Tropsch process, has an Oxidator A value of less than about 1. The examiner is of the position that the Fischer-Tropsch derived oils set forth in Wittenbrink may and most likely do also have an Oxidator A value of less than 1 but were not characterized as such. It has been well known in the art that Fischer-Tropsch derived hydrocarbon oils are prone to oxidation because they contain almost no sulfur which is a natural antioxidant. As set forth in Wittenbrink, premium synthetic lubricant base stocks of high purity may be derived from waxy Fischer-Tropsch hydrocarbons which contain contaminants such as sulfur, nitrogen and metals in

Art Unit: 1764

amounts of less than 1 wppm. See column 3, line 64 to column 4, line 1. Applicant has amended component (b) of the claims to include the phrase “the non-synthetic lube base oil has an Oxidator BN value in the presence of additives of less than about 7” and applicant argues that this distinguishes the claims over Wittenbrink. This is not deemed to be persuasive because the “additives” are not taught; and, as previously set forth, Wittenbrink teaches that fully formulated lubricating oils may be prepared by adding to the base stock an effective amount of at least one additive or, more typically, an additive package containing more than one additive wherein the additive is an antioxidant. See column 4, lines 50 et seq. The Declaration under Rule 132 setting forth Oxidator BN values for various lubricating oils has been considered. Only 9 of the 38 oils tested have an Oxidator BN value less than 7 which is required by the claims. However, the additives in the basestocks have not been set forth and it would seem that the Oxidator BN value is dependent upon both the type and amount of additives. Presumably the same additive package has been added to the various base stocks to show a comparison of the different base stocks. In any event, Wittenbrink also teaches fully formulated lubricating oils and, although not describing the oils in terms of an Oxidator BN value, the oils of Wittenbrink may be the same as the oils applicant requires for component (b) of the claims. The examiner maintains the position that it is not clear that the claims at issue differ from the possible oil compositions taught by Wittenbrink.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 7-28 of copending Application No. 09/882,709. Although the conflicting claims are not identical, they are not patentably distinct from each other because the lubricant base oil blends which comprise Fischer-Tropsch synthesized hydrocarbons and additional basestocks may be the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

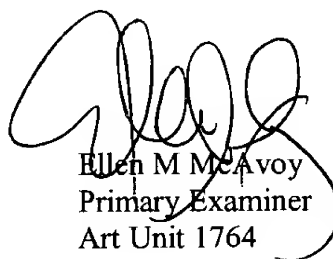
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

Art Unit: 1764

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (703) 308-6824. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
August 25, 2003